

REMARKS

Claims 1-18 were previously pending in the application. The following remarks, in conjunction with the above presented amendments, are believed to be fully responsive to the Office Action mailed April 4, 2005. Claims 1, 7, 13 and 15 are the independent claims. Favorable reconsideration is requested.

In the Office Action claims 7-12 and 13-18 stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In the Office Action claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pattichis (Neural Network Models in EMG Diagnosis; May 5, 1995) in view of Gulati (US 6,780,589).

The 35 U.S.C. §101 Rejections

Applicants have amended each of independent claims 7, 13 and 15 to recite a computer system or a computer program, as recommended by the Office Action. Accordingly this rejection is now obviated and is respectfully requested to be removed.

The 35 U.S.C. §103(a) Rejections

As described throughout the specification, the present invention addresses a comprehensive description of a human being's health picture or wellness. Specification at ¶ 59 ("the information extraction phase consists of obtaining a complete and comprehensive snapshot of the individual's health picture"). This snapshot can be obtained, for example, by a user interacting with a complicated and unique taxonomy designed to comprehensively describe a human's health picture. Specification at ¶ 68, and ¶¶ 161-186. The snapshot is articulated, for

example, as a Patient Descriptive Vector or “PDV.” Specification at ¶ 78-96. This allows an exemplary system to, using a defined exemplary metric, find similar snapshots. Specification at ¶¶ 202-208.

Articulating such an exemplary system, claim 1 is directed to a system comprising an automated interactive acquirer of data comprehensively descriptive of a particular system, a data processor; and a reporter to report the conclusions of the data processor. Moreover, the method provides that the system described is the comprehensive medical state of a human being. Independent claims 7, 13 and 15 recite similar features.

In contrast to a comprehensive health snapshot of a human being, the cited prior art is not seen as teaching, whether alone or in combination, all of the elements of any of independent claims 1, 7, 13 and 15 as amended. Thus each of the pending independent claims, as amended are asserted as patentable over the cited prior art, whether alone or in combination.

Moreover, Applicants do not understand the Examiner’s stated motivation to combine the Pattichis and Gulati references as articulated on page 4, Item 5(A) of the Office Action:

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Gulati within the system of Pattichis with the motivation of providing a technique that can identify mutation signatures within dot spectrograms even in circumstance wherein the signal to noise ratio is extremely low.

Office Action at page 4.

This motivation is repeated in connection with claims 7, 13 and 15. It has little, if anything, to do with a comprehensive snapshot of a human being’s medical state.

The MPEP states, at Section 706.02(j), that to establish a *prima facie* case of obviousness there must be some suggestion in the references or in the knowledge generally available to one of ordinary skill in the art to combine reference teachings. Addressing this exact issue, the Federal Circuit recently stated:

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some “teaching, suggestion or reason” to combine cited references. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ 2d 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), limited on other grounds by *In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher).

Whether a motivation to combine prior art references has been demonstrated is a question of fact. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). The assessment of whether to combine references in a given case has sometimes been viewed conceptually as a subset of the first Graham factor, the scope and content of the prior art. See, e.g., *id.*; *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881-83, 886, 45 USPQ2d 1977, 1981-82, 1985 (Fed. Cir. 1998). Although that view is not incorrect, accurate assessment of whether to combine references may require attention to other Graham factors. For example, the level of skill in the art may inform whether the artisan would find a suggestion to combine in the teachings of an exemplar of prior art. Where the level of skill is high, one may assume a keener appreciation of nuances taught by the prior art. Similarly, appreciation of the differences between the claims in suit and the scope of prior art references—a matter itself informed by the operative level of skill in the art—informs the question of whether to combine prior art references. At bottom, in each case the **factual inquiry whether to combine references must be thorough and searching.** (emphasis added)

McGinley v. Franklin Sports Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). Further amplifying this holding, the Federal Circuit added:

In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

In re Lee, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

There must be a connection between the stated motivation to combine and the claimed invention. Thus what must be shown is a motivation to *someone skilled in the art of the*

claimed invention to combine the references to *yield the claimed invention*! None has been shown. Thus Applicants respectfully traverse the stated – yet irrelevant to the invention – motivation to combine. There is no demonstration at all of a “teaching or suggestion to make the claimed invention” or “any reasonable expectation of success” of such an endeavor. MPEP 706.02(j).

Even if this improper combination to teach the claimed invention were valid, which it is not, it would not teach every element of the claimed invention as recited in any of the independent claims. Pattichis is not concerned with a total health picture of a human being. This much is admitted in the Office Action at 4. Gulati cannot cure this defect of Pattichis, as Gulati is directed to image processing and signal amplification in the context of a DNA microarray of a biological sample, and is not at all concerned with a comprehensive description of the medical state of a human being. Contrary to the assertions of the Office Action at item 5(B), page 4, Gulati at 7:35-50 does not teach or even suggest describing a comprehensive medical state of a human being, as is recited in each of the independent claims as amended. It describes describing a set of mutations of interest of DNA. Nothing more.

For at least these reasons, each of amended independent claims 1, 7, 13 and 15 are urged as patentable over the cited prior art. The remaining claims are each dependent upon one of the independent claims, and are thus patentable for similar reasons.

If there are any questions remaining as to patentability of the pending claims, Applicants would very much desire to have an interview with the Examiner, review same, and verbally present their point of view. The Examiner is thus invited to notify Applicants’ undersigned attorney if such questions remain so that an interview can be scheduled.

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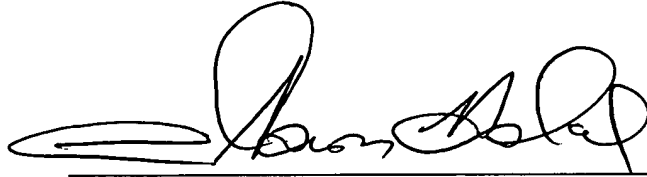
Attorney Docket No.: 059376/00002

No other fee is believed to be due in connection with the submission of these papers.

However, the Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment to Deposit Account No. 50-0540.

Dated: October 3, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Aaron S. Haleva', written over a horizontal line.

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